

PATENTIN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Lalitha Vaidyanathan; Examiner: Naresh Vig
John Quinn; Ahmed
Khaishgi; Cara Cherry
Serial No.: 09/504,159 Group Art Unit: 3629
Filed: February 15, 2000 Docket No.: 1018-001US01
Title: ELECTRONIC DISPUTE RESOLUTION SYSTEM

CERTIFICATE UNDER 37 CFR 1.8: I hereby certify that this correspondence is being deposited via facsimile with the Commissioner for Patents, Washington, D.C. 20231 on 1/17, 2003.

By: Samantha J. Rupert
Name: Samantha J. Rupert

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☒ Response and Request for Reconsideration (10 pgs.)

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By:

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Naresh Vig	Kent Sieffert	
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NOTES/COMMENTS:

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RESPONSE UNDER 37 C.F.R. 1.116
EXPEDITED PROCEDURE
EXAMINING GROUP 3629

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants:	Vaidyanathan, Lalitha; Quinn, John; Khaishgi, Ahmed; Cherry, Cara	Examiner:	Naresh Vig
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Name: Samantha J. Rupert

RESPONSE AND REQUEST FOR RECONSIDERATION UNDER 37 C.F.R. § 1.116

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Commissioner for Patents
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JAN 21 2003

GROUP 3600

Dear Sir:

In response to the Final Office Action mailed November 22, 2002, the period of response for which runs through January 22, 2002, Applicants respectfully requests reconsideration.

REMARKS

This amendment is responsive to the Final Office Action dated November 22, 2002. Claims 1-31 and 56-74 are pending.

Finality of the Office Action

As a preliminary matter, Applicants respectfully requests that the Examiner reconsider the finality of the Office Action. "Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is

neither necessitated by applicants' amendment of the claims nor based on information submitted in an information disclosure statement....¹ "Furthermore, a second or any subsequent action on the merits in any application...shall not be made final if it includes a rejection, on newly cited art...of any claim not amended by applicants...."²

In the Office Action, the Examiner introduced new grounds of rejection of each of Applicants' pending claims. Further, the Examiner cited new art against many of those claims. The newly cited art includes U.S. Patent No. 6,363,384, issued to Eugene N. Cookmeyer, II, et al. (hereinafter "Cookmeyer"), U.S. Patent No. 5,839,905, issued to Anthony A. Main, et al. (hereinafter "Main"), and web pages ostensibly generated by Bell Atlantic Communications, Inc. in 1998 and 1999 (hereinafter "the Bell Atlantic web pages").

Moreover, In Applicants' Response and Request for Reconsideration filed October 23, 2002, to which this Office Action is responsive, Applicants made no amendments to the claims. Further, Applicants has not submitted an information disclosure statement during the prosecution of this application. Therefore, the finality of the Office Action is clearly premature, and impermissible under the MPEP. Applicant request withdrawal of the finality of the rejections.

Claim Rejections Under 35 U.S.C. § 103

In the Office Action, the Examiner rejected claim(s) 1-13, 15-19, 22-29 and 56-74 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,895,450, issued to Marshall A. Sloo (hereinafter "Sloo") in view of Cookmeyer. In addition, the Examiner rejected claim 14 under 35 U.S.C. § 103(a) as being unpatentable over Sloo in view of Cookmeyer in further view of U.S. Patent No. 6,330,551, issued to James D. Burchetta et al. (hereinafter "Burchetta"). The Examiner also rejected claims 20, 21 and 26 under 35 U.S.C. § 103(a) as being unpatentable over Sloo in view of Cookmeyer in further view of Main. Finally, the Examiner rejected claims 30 and 31 under 35 U.S.C. § 103(a) as being unpatentable over Sloo in view of Cookmeyer in further view of the Bell Atlantic web pages. Applicants respectfully traverse these rejections. The applied references fail to disclose or suggest the inventions defined by Applicants' claims, and provide no teaching that would have suggested the desirability of modification to arrive at the claimed invention.

¹ M.P.E.P. § 706.07(a).

Claims 1, 56 and 64

In rejecting Applicants' claims, the Examiner relies primarily on the disclosure of Sloo. However, as acknowledged by the Examiner, Sloo fails to disclose certain requirements of each of Applicants' independent claims 1, 56 and 64.³ For example, Sloo fails to disclose "applying a case-based reasoning system to the case information to produce a result for use in selection of a mode of resolving the dispute," as required by claim 1, "comparing the case information to facts of previously resolved disputes to produce a result for use in selection of a mode of resolving the dispute," as required by claim 56, and a server that "compares the case information to the facts of previously resolved disputes stored by the database to produce a result for use in selection of a mode of resolving the dispute," as required by claim 64.

The Examiner attempts to rely on the disclosure of Cookmeyer in an effort to overcome these deficiencies of Sloo. This reliance is clearly misplaced. Cookmeyer does not disclose or suggest these requirements of Applicants' claims. In fact, Cookmeyer is in not even remotely related to electronic dispute resolution. Instead, Cookmeyer discloses an expert system for analyzing network protocols, e.g., Ethernet, Token Ring, and the like. Applicants are baffled as to why one skilled in the art would look to a protocol analyzer for solving the deficiencies of Sloo.

Moreover, Cookmeyer merely discusses an analyzer that "combines a rules based knowledge base together with a structured interview analysis which allows the user to follow interview questions in focusing the problem definition."⁴ The Examiner has done nothing more than select a reference to demonstrate a rule-based computing system that can be used for problem solving, e.g., a protocol analyzer of Cookmeyer for identifying network problems. Applicant has no doubt that the Examiner could have selected any of a multitude of references for this proposition. However, the proposition is wholly unrelated to Applicants' claims, and clearly fails to teach or suggest the comparison on case information to assist in selection of a mode for resolving a dispute. Sloo clearly fails to show this, as readily admitted by the

² Id.

³ See Office Action, page 5.

⁴ Cookmeyer, column 6, lines 49-52.

Examiner. Where is this shown in Cookmeyer? Is the Examiner really suggesting that a protocol analyzer having an expert system for identifying network problems could be used to modify the complaint handling system of Sloo? Even if combined, these references result in a clearly deficient system. **Where do either of these reference teach or suggest that the use of information from previous cases may be useful in selecting a mode of resolution for a dispute?** Applicants have repeatedly asked the Examiner to clearly identify where the prior art teaches or suggests these and other claimed features. Again, the Examiner relies on unrelated prior art that fail to even remotely describe Applicants' claims.

Even assuming that Cookmeyer and Sloo could be combined to reach the Applicants' claimed inventions, the Examiner fails to explain why one of skill in the art would be motivated to do so. Specifically, the Examiner has failed to explain why one of ordinary skill in the art would have looked to expert system for network analysis of Cookmeyer, the disclosure of which is completely unrelated to electronic dispute resolution, for modification of the electronic dispute resolution system of Sloo.

The Court of Appeals for the Federal Circuit has made clear that motivation to combine references must be found in the prior art, and that it is impermissible hindsight for the Examiner to use the motivation stated in Applicants' own disclosure as a blueprint to reconstruct the claimed invention from the prior art.⁵ In other words, the Examiner cannot under established law merely pluck such motivation out of thin air, as is evident with this and previous Office Actions. Rather, the Examiner's rejection must be based on substantial evidence in the record demonstrated that the motivation for making the claimed invention resides in the prior art.⁶ In other words, the Examiner must provide substantial evidence that demonstrates that a person of ordinary skill in the art would reasonably be expected or motivated to look to the expert system for network analysis of Cookmeyer in order to modify the electronic dispute resolution system of Sloo.⁷ The Examiner simply cannot rely on his or her own concocted motivation.

⁵ See *Interconnect Planning Corp. v. Feil*, 227 USPQ 543 (CAFC 1985); see also *In re Fine*, 5 USPQ2d 1596, 1598 (CAFC 1988); see also *In re Gorman*, 18 USPQ 2d 1885, 1888 (CAFC 1991); see also *Al-Site Corp. v. VSI International, Inc.*, 50 USPQ2d 1161, 1171 (CAFC 1999).

⁶ *In re Lee*, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002); *In re Chu*, 36 USPQ2d at 1094.

⁷ See *In re Oetiker*, 24 U.S.P.Q.2d 1443, 1446 (Fed. Cir. 1992).

Here, the Examiner stated "it would have been obvious to a person with ordinary skill in the art to analyze the outcome prior to selecting a method to minimize on time it takes to handle complaints and increase customer satisfaction." Where is this found in the prior art?

The Examiner has cited no evidence in the record, much less substantial evidence, that demonstrates such a motivation. Indeed, it is likely that no such evidence of motivation exists considering the remoteness of Cookmeyer from the field of Applicants' inventions. Such evidence is clearly not found in Sloo. As argued in detail in Applicants' previous Amendment and Response, the disclosure in Sloo of "comparing the characteristics from the current record to characteristics from data records from previously resolved complaints to arrive at an appropriate judgment"⁸ is entirely counter to Applicants' claims that recite application of a case-based reasoning system to produce a result for use in selection of a mode of resolving the dispute because the comparison occurs after a mode has already been selected.

In the absence of such evidence, the Examiner merely states "it would have been obvious to a person with ordinary skill in the art to analyze the outcome prior to selecting a method to minimize on time it takes to handle complaints and increase customer satisfaction." This conclusion of obviousness clearly relies on a motivation plucked directly from Applicants' own disclosure, rather than the prior art.⁹ Moreover, it is clear that the Examiner has improperly used Applicants' disclosure as a blueprint to reconstruct Applicants' claimed inventions using Cookmeyer – a reference so unrelated to the field of Applicants' claimed inventions that one skilled in the art would not be expected to refer to it in the absence of clear motivation to do so.

In summary, the Examiner's conclusion of obviousness, and particularly the cited motivation to modify Sloo in view of Cookmeyer, is unsupported by any substantial evidence in the record. Therefore, the Examiner has failed to establish a prima facie case of unpatentability of any of Applicants' pending claims under 35 U.S.C. § 103(a) based on the combination of Sloo and Cookmeyer, and should withdraw the rejections of all of Applicants' pending claims.

⁸ Sloo discloses the function of comparing the characteristics from the current record to characteristics from data records from previously resolved complaints only in conjunction with a third option – the "Automatic Negotiator" [which] allow[s] the system to determine a resolution to the dispute." See column 7, lines 37-39.

⁹ See Application, page 8, line 11-20 (discussing the increase in efficiency that may achieved by Applicants' inventions that include the above mentioned requirements).

Claims 2, 7-13, 15-19, 28-29 and 72

With respect to claims 2, 11-13, 15-19 and 72, the Examiner continues to rely on the same hypothetical situations and unsupported statements of common knowledge in the art proffered in the previous Final Office Action dated August 22, 2002. Applicants thoroughly and seasonably traversed these rejections in the subsequent Response and Request for Reconsideration received by the Examiner on October 23, 2002. According to M.P.E.P. § 2144.03, the Examiner should have responded to these seasonable challenges by providing evidence, or an explanation as to why such evidence was unnecessary. The Examiner has done neither. Therefore, the Examiner must withdraw the rejections of these claims, cite a reference to support the assertions of common knowledge, or provide an explanation of why such evidence is unnecessary.

With respect to claims 7-10, as discussed in the previous Response and Request for Reconsideration, Sloo does not disclose or suggest receiving more than one settlement position from more than one party, as required by claim 7, much less automatically settling the dispute based on the received settlement positions, as required by claim 8. Although the Examiner cites a passage of Cookmeyer involving the automatic setting of threshold values and inference of priority ranking of the sensed network events,¹⁰ it is clear that the Examiner relies on "business rules," i.e. knowledge that is allegedly common in the art, to provide these requirements of Applicants' claims that are absent from the disclosure of Sloo.¹¹ Applicants respectfully and seasonably traverse these rejections, and request that the Examiner withdraw the rejections of these claims or cite a reference to support the assertion of common knowledge.¹²

It appears that the Examiner now has a more accurate understanding of claims 28 and 29. However, the Examiner once again relies on unsupported statements of common knowledge in the art to support the rejections of these claims. While it may have been known in the art to

¹⁰ The fact that Cookmeyer discloses the automatic performance of some function that is wholly unrelated to automatic dispute resolution is patently insufficient to make a prima facie case for the obviousness of Applicants' claim 8-10, which require automatically settling a dispute if settlement positions received from the parties satisfy a predetermined criteria.

¹¹ However, the "business rules" cited by the Examiner are at least as incapable of supporting a prima facie case of obviousness as the cited passage of Cookmeyer. That an employee may be granted the authority to choose from a variety of techniques for solving a dispute bears no relation to Applicants' claims which require receiving settlement positions from parties and automatically settling a dispute if settlement positions received from the parties satisfy a predetermined criteria.

¹² See M.P.E.P. § 2144.03.

provide customers with recourse in case of disputes regarding the goods or services provided, it was not common knowledge at the time of Applicants' invention to provide electronic dispute resolution an insurance for transactions, as required by claim 28. Moreover, although Sloo discloses registration of a user, Sloo does not disclose requiring a seller in a transaction to be a registered subscriber before a transaction is insured, as required by claim 29. Applicants respectfully and seasonably traverse these rejections, and request that the Examiner withdraw the rejections of these claims or cite a reference to support the assertion of common knowledge.¹³

Claims 6, 62-63 and 70-71

Neither Sloo nor Cookmeyer disclose or suggest presenting an outcome prediction that includes one or more [at least one] likely outcomes and associated probabilities of occurrence as required by claims 6, 62, and 70, or presenting the outcome prediction to the parties as a potential resolution of the dispute as required by claims 63 and 71. It appears that the Examiner may not have addressed these requirements of Applicants' claims in the Final Office Action. In any event, none of the passages of Sloo cited by the Examiner in rejecting claims 4-6, 57-63, and 65-71 disclose or suggest these requirements.¹⁴ Consequently, the Examiner has failed to establish a prima facie case of unpatentability of these claims under 35 U.S.C. § 103, and the rejections of these claims should be withdrawn.

Claim 14

The Examiner continues to rely on the combination of Sloo with Burchetta in an effort to establish the obviousness of claim 14. Further, it appears that the Examiner continues to misunderstand either the scope of Burchetta or of claim 14. Burchetta does not disclose or suggest creating a contract between the one or more parties stating the willingness to abide by a recommended resolution that has been generated by a dispute resolution specialist," as required by claim 14. As argued in the previous Response and Request for Reconsideration, in contrast to this requirement of claim 14, Burchetta discloses that a previously obtained user agreement binds

¹³ See M.P.E.P. § 2144.03.

¹⁴ In contrast to presenting the outcome prediction to the parties as a potential resolution of the dispute as required by claim 63 and 71, Sloo discloses comparing facts of previously resolved disputes to the current dispute only in the context of determining a resolution of the dispute without the participation of the parties. See column 9, line 57 – column 10, line 34.

the claimant to settle the claim for the amount specified by the on-line dispute settlement system based on the comparison of demands and offers received from the parties to each other and preestablished conditions.¹⁵

The portion of Applicants' disclosure quoted by the Examiner is particularly instructive in illustrating the difference between the disclosure of Burchetta and claim 14. "The dispute resolution specialist also generates a final recommended resolution that, once accepted by the one or more parties, is recited in a binding contract between the one or more parties stating a willingness to abide by the final recommended resolution."¹⁶ In other words, the disclosure in Burchetta of a user agreement that binds users to the result of specified by the system before the system reaches the result is directly contrary to the requirement of claim 14 that a resolution first be recommended and then a contract be created accepting the recommended resolution. Consequently, the Examiner has failed to make a prima facie case of unpatentability of claim 14 under 35 U.S.C. § 103(a) based on the combination of Sloo, Cookmeyer and Burchetta, and should withdraw the rejection of this claim.

Claim 20, 21 and 26

As acknowledged by the Examiner, Sloo fails to disclose the requirements recited each of claims 20, 21 and 26.¹⁷ Specifically, Sloo fails to disclose "providing visual cues to highlight agreements between the parties," as recited by claim 20, "visually highlighting areas of agreement and disagreement," as recited by claim 21, and "highlighting an offender in the dispute resolution system," as recite by claim 26. The Examiner therefore relies on the disclosure of Main in an effort to overcome these deficiencies of Sloo.

However, Main does not disclose or suggest any these requirements of Applicants' claims. In fact, Main is in not even remotely related to electronic dispute resolution. Instead, Main discloses a "system and method for monitoring the performance of selected data processing jobs...."¹⁸

¹⁵ Burchetta, column 2, lines 3-17.

¹⁶ Application, page 2, lines 7-11.

¹⁷ See Office Action, page 18.

¹⁸ Main, abstract.

It appears that the Examiner has again improperly used Applicants' disclosure as a blueprint to reconstruct Applicants' claimed inventions. The Examiner has cited no evidence in the record, much less substantial evidence, that demonstrates a motivation to use the performance monitoring system and method of Main modify the electronic dispute resolution system of Sloo. Indeed, it is likely that no such evidence of motivation exists considering the remoteness of Main from the field of Applicants' inventions. Such evidence is clearly not found in Sloo, which does not in any way suggest the requirements recited in claims 20, 21 and 26.

Indeed, it appears that the Examiner rests the argument of unpatentability of claim 20, 21 and 26 on a mere seven lines plucked out of Main, a reference that is completely unrelated to Applicants' field of endeavor, based on motivation found only in Applicants' disclosure or drawn from the ether. Further, the Examiner has failed to recognize that these seven lines at best illustrate that it is known to highlight things on a screen by changing their color, causing them to blink, or the like. These seven lines when considered in combination with the disclosure of Sloo do not even approach suggesting a modification of Sloo to include "providing visual cues to highlight agreements between the parties," as recited by claim 20, "visually highlighting areas of agreement and disagreement," as recited by claim 21, and "highlighting an offender in the dispute resolution system," as recited by claim 26.

In summary, the Examiner's conclusion of obviousness, and particularly the cited motivation to modify Sloo in view of Main, is unsupported by any substantial evidence in the record. Therefore, the Examiner has failed to establish a prima facie case of unpatentability of any of claims 20, 21 and 26 under 35 U.S.C. § 103(a) based on the combination of Sloo, Cookmeyer and Main, and should withdraw the rejections of all of Applicants' pending claims.

It is believed that this application is condition for allowance. Early notice to this effect is earnestly solicited. Please charge any additional fees or credit any overpayment to deposit account number 50-1778. The Examiner is invited to telephone the below-signed attorney to discuss this application.

Date:

By:

January 17, 2003
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